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www.uspto.gov

Paper No.

Michael I. Stewart
Sim & McBurney, 6th Floor
330 University Avenue
Toronto, ON M5G 1R7 CA CANADA

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DEC 06 2004

OFFICE OF PETITIONS

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|-------------------------------|---|---------------------|
| In re Application of: | : | |
| Sokoll et al. | : | |
| Application No. 10/620,686 | : | DECISION DISMISSING |
| Filed: July 17, 2003 | : | PETITIONS UNDER |
| Title of Invention: | : | 37 CFR 1.47(a) AND |
| BIODEGRADABLE TARGETABLE | : | 37 CFR 1.137(b) |
| MICROPARTICLE DELIVERY SYSTEM | : | |

This is in response to the Petitions Under 37 CFR § 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s), and 37 CFR 1.137(b), to revive the above application.

The petitions are dismissed.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor, AND BE ADDRESSED TO petitions Attorney Derek L. Woods. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 2, 2004, without, a fully executed oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), on October 20, 2003, requiring *inter alia*, a properly signed oath or declaration. Applicant was given two (2) months to respond to the Notice, and extensions of time under 37 CFR 1.136 were available. No reply having been received, the application became abandoned December 21, 2003.

In response to the Notice, Applicant files a petition to revive the application under 37 CFR 1.137(b), and a petition to allow

the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s) under 37 CFR 1.47(a).

Applicable Law

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed); (2) the petition fee required by 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) if required, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

Applicant lacks item (1), the required reply which, in this instance, is a grantable petition under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), where it is alleged that an applicant refuses to join an application, the applicant must establish that the nonsigning inventor was presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

The instant petition

Here, the Declaration of Reza Yacoob provides that a declaration and power of attorney were forwarded to the inventor, but there is no assertion that the application was sent to the inventor. There is also no verification that the documents were received. Attachments sent via email require evidence of receipt by the inventor because, depending on the electronic medium, attachments are sometimes inaccessible.

The Declaration of Reza Yacoob also avers that the inventor has moved and there is no street address at which to contact the inventor. Applicant is advised that, where an inventor is unavailable (cannot be reached), while it is not required that the application be mailed, Petitioner must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. A statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. (Emphasis supplied). See, MPEP § 409.03(d). At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventor may reside. Copies of the results of such searches must be referred to in any renewed petition. It is important that the forthcoming communication contain statements of fact as opposed to conclusions. See, MPEP § 409.03(d).

Applicant must either provide confirmation that the application, sent via email, was received by the inventor, i.e., a return email from the inventor evidencing receipt of the application, or provide evidence that the inventor cannot be found or reached after diligent effort.

Further correspondence with respect to this matter should be addressed as follows:

By FAX: (703) 872-9306
Attn: Office of Petitions

By hand: 2201 South Clark Place
Customer Window
Crystal Plaza Two, Lobby Room 1B03
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed
to the undersigned at (571) 272-3232.

Derek L. Woods
Derek L. Woods
Attorney Advisor
Office of Petitions